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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/579,933	05/26/2000	David V. Goeddel	P0960R1D1C2	9126

7590

09/03/2002

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EXAMINER
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SCHEINER, LAURIE A

ART UNIT	PAPER NUMBER
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1648

DATE MAILED: 09/03/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/579,933

Applicant(s)

Goeddel et al.

Examiner

Laurie Scheiner

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 10, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 35-37 and 39-42 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35-37 and 39-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

Art Unit: 1648

Claims 35-37 and 39-42 are pending in this application.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 35-37 and 39-42 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for reasons of record

Applicant's arguments filed April 10, 2002 have been fully considered but they are not persuasive. Essentially, applicants defend their position of an adequate written description by pointing to the last paragraph on page 32 of the instant specification. The examiner contends that the argument is insufficient to support a position that applicants were at the time of filing, in possession of a functional method of treating an Epstein-Barr associated tumor since the referenced passage merely sets forth that the "I-TRAFs of the present invention **may** inhibit the downstream effects of LMP1". No more than a theoretical premise has been set forth.

Applicants clearly fail to present functional experimental outcomes which remotely correspond to an efficacious or prophylactic treatment of EBV associated tumor. A preliminary theoretical concept is not supportive of a method claim purporting efficacy. Again, that which applicants claim fails to correspond to that which is described. That is, the claims are drawn to a pharmaceutical formulation (vaccine) as well as methods of treating patients having (or at risk of having) Epstein-Barr associated virus tumors with a therapeutically acceptable amount of an I-TRAF. However, the specification, at best, merely states that the I-TRAF of the present

Art Unit: 1648

invention may inhibit the downstream effects of LMP1. To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. This requirement promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their specifications for the benefit of the public in exchange for the right to exclude others from practicing the invention for the duration of the patent's term. Moreover, there is an inverse correlation between the level of predictability in the art and the amount of disclosure necessary to satisfy the written description requirement. Clearly, the predictability of this particular art is quite low, therefore necessarily requiring a disclosure which would more reasonably place the technology in the hands of the skilled artisan. One of ordinary skill in the art at the time of the invention would be unable to practice the invention as claimed due to a wholly inadequate written description. The written description requirement under Section 112, first paragraph, sets forth that the claimed subject matter must be supported by an adequate written description that is sufficient to enable one skilled in the art to make and use the invention. The courts have concluded that the specification must demonstrate that the inventor(s) had possession of the claimed invention as of the filing date relied upon. Although the claimed subject matter need not be described identically, the disclosure relied upon must convey to those skilled in the art that applicants had invented the subject matter claimed. *In re Wilder, et al.*, 222 U.S.P.Q. 369 (C.A.F.C. 1984). *In re Wertheim, et al.*, 191 U.S.P.Q. 90 (C.C.P.A. 1976). *In re Driscoll*, 195 U.S.P.Q. 434 (C.C.P.A. 1977). *Utter v. Hiraga*, 6 U.S.P.Q.2d 1709 (C.A.F.C. 1988). *University of California v. Eli Lilly*, 119 F.3d 1559, 43 U.S.P.Q.2d 1398 (Fed. Cir. 1997). *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 18 U.S.P.Q.2d 1016-1031 (C.A.F.C. 1991). *Fiers v. Sugano*, 25

Art Unit: 1648

U.S.P.Q.2d 1601-1607 (C.A.F.C. 1993). In short, applicants may have determined that I-TRAFs of the present invention **may** inhibit the downstream effects of LMP1. However, applicants have not adequately conveyed to the skilled that they were in possession of functional prophylactic and therapeutic methods.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Scheiner, whose telephone number is (703) 308-1122. Due to a flexible work schedule, the examiner's hours typically vary each day. However, the examiner can normally be reached Monday thru Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (703) 308-4027. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703) 308-0196.

Correspondence related to this application may be submitted to Group 1600 by facsimile transmission. The faxing of such papers must conform with the notice published in

Art Unit: 1648

the Official Gazette, 1096 OG 30 (November 15, 1989). Official communications should be directed toward one of the following Group 1600 fax numbers: (703) 308-4242, (703) 305-3014, (703) 872-9306 or (703) 872-9307. Informal communications may be submitted directly to the Examiner through the following fax number: (703) 746-5226.



Laurie Scheiner/LAS  
August 28, 2002



LAURIE SCHEINER  
PRIMARY EXAMINER